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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/751,765

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Pierluca Lombardi

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10/28/2009

Law Office of Alan W. Cannon
942 Mesa Oak Court
Sunnyvale, CA 94086

EXAMINER

GILBERT, ANDREW M

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

10/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/751,765	Applicant(s) LOMBARDI, PIERLUCA	
	Examiner ANDREW M. GILBERT	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 15, 16, 18-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21, 23 and 27 is/are allowed.
- 6) ☒ Claim(s) 13, 15, 16 and 24-26 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/6/2009 has been entered.

Acknowledgments

1. This office action is in response to the reply filed on 10/6/2009 and 8/13/2009.
2. In the reply, the Applicant amended claims 13 and 21. Claims 19-20 were previously withdrawn.
3. Thus, claims 13, 15-16, 18, 21, 23-27 are pending for examination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13, 15-16, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (4623335) in view of Treu (5630935). Jackson discloses an apparatus for regulating pressure applied during a medical procedure, comprising: an inelastic housing (24) enclosing an inner volume, the housing having a first and second

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end (respective ends of syringe 24 and 26) wherein the housing (10; or all elements basically forming the device structure such as 24, 26, 40, 22, 44, 64, etc... the applicant has not structurally defined the housing to preclude elements 64 from forming a part of the housing) comprises a cylindrical inelastic housing enclosing the inner volume (can include all inner volumes – from 24 to 58) and a plunger (25); an aperture (56) in the housing for conveying pressure from the housing during medical procedure, and a pressure-operated valve (22; Fig 2) coupled between the inner volume of the housing and a space outside of the inner volume of the housing for allowing pressure to escape from the inner volume of the housing through the valve when pressure in the housing exceeds a threshold, whereby the valve releases pressure from within the inner volume of the housing (Figs 1-4; col 5, lns 32-col 6, lns 3); wherein the pressure operate valve comprises an opening (68), a plunger (44) disposed within the inner volume of the housing; a spring (52) disposed within the inner volume of the housing, wherein the spring is positioned between the second end of the housing and the plunger (Fig 2), wherein the plunger in a rest position is between the opening and the aperture (Fig 2), and wherein as fluid is inserted into the inner volume of the housing via the aperture, increased pressure within the inner volume of the housing moves the plunger toward the opening (Figs 1-4; col 5, lns 32-col 6, lns 3); wherein the opening is positioned in a side of the housing providing access to the inner volume of the housing (68; Fig 2), wherein at normal pressure the opening is closer to the second end than the plunger and wherein as pressure within the inner volume of the housing increases so as to move the plunger past the opening (Figs 1-4), the pressure within the inner housing is

released through the opening (Figs 1-4; col 5, lns 32-col 6, lns 3); wherein the threshold is set by a spring exerting a force which must be overcome to exceed the threshold (Figs 1-4; col 5, lns 32-col 6, lns 3).

6. However, Jackson does not disclose that the pressure operated valve is adapted to allow selection of the threshold, during use, from a plurality of different pre-set thresholds; wherein a movable member which can be positioned between at least two different positions corresponding to different forces of the spring which must be overcome to exceed the threshold. Treu teaches that it is known to have a pressure operated valve adapted to allow selection of the threshold during use from a plurality of different thresholds (130; 144; col 9, lns 56-67; wherein the user controls the force and thus the threshold via the adjustment member) and a movable member (140) which can be positioned between at least two different positions corresponding to different forces of the spring which must be overcome to exceed the threshold (col 9, lns 56-67) for the purpose of controlling the threshold value. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the spring system as taught by Jackson with the spring system adapted to allow selection of the threshold as taught by Treu for the purpose of controlling the threshold valve.

Allowable Subject Matter

1. Claims 21, 23, 27 are allowed.
2. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 3/3/2009 have been fully considered but they are not persuasive.

8. The Applicant argues that:

i. Element 18 of Jackson is not an aperture in the housing and that valve 22 comprising a plunger 60 is simply a conduit and neither, including spring 52 are disposed within the inner volume of the housing.

ii. Treu does not disclose a pressure-operated valve provided with discrete threshold setting features, being selectable by a user to select a discrete, pre-set threshold pressure level from a plurality of different discrete pre-set threshold pressure levels.

9. In response to the applicant's argument (i), the Examiner notes that corrections have been made in the rejection above clarifying the elements in Jackson as they pertain to the applicant's claimed invention. Specifically, the aperture in the housing is 56, the housing is defined as the entire structure of the Jackson device, the valve 22 is fully capable of being considered a valve because it performs the function of a valve as plunger 60 prevents the release of pressure in one position until a threshold is reached and then allows the release of pressure in a second position (see e.g. Figs 2, 4 of Jackson) and the applicant has not provided structural definition in the claims to the valve.

10. In response to applicant's argument (ii), the Examiner notes that "pre-set" is defined as "to set in advance" by Webster's dictionary. Further, "discrete" is defined by

Webster's as "consisting of distinct or unconnected elements" or "taking on or having a finite or countably infinite number of values." Treu provides a pressure operated valve with "discrete threshold setting features" – namely spring 144 and controller 130 that controls the force of the spring. Each feature is selectable by the user, in other words controlled by the user, to select a value – the force of the spring and consequently, the pressure release threshold. The Examiner notes that the Applicant has not defined the discrete pressure values – there is no limitation denoting if each discrete value represents a .01/psi threshold difference for example. The spring 144 and controller 130 provide a finite or countably infinite number of valves of a possible threshold value in Treu that the user can select from prior to use. Additionally, a user could go even further and could use the discrete threshold features to select a discrete threshold by performing one full rotation of the controller 130, or two full rotations of the controller 130 to reach a second discrete threshold, etc...). It is submitted that the member of Treu while continuously adjustable member is also falls within the applicant's claim scope and is fully capable of acting as a discrete threshold setting feature under the interpretations discussed. Further structural definition is required.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW M. GILBERT whose telephone number is (571)272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew M Gilbert/
Examiner, Art Unit 3767

/Kevin C. Sirmons/
Supervisory Patent Examiner, Art Unit 3767